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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,064	12/27/2001	James M. Foley	40655.3400	3303
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FITZPATRICK CELLA HARPER & SCINTO				
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NEW YORK, NY 10112				
EXAMINER				
SCHUBERT, KEVIN R				
ART UNIT		PAPER NUMBER		
2137				

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,064

Applicant(s)

FOLEY ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 14-16 and 19-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7, 14-16 and 19-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-7, 14-16, and 19-22 have been considered.

Continued Examination Under 37 CFR 1.114

5 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/06 has been entered.

Specification

The Specification is objected to in accordance with the 35 U.S.C. 112, first paragraph, rejection of claims 2,6,20, and 22.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

20 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

25 Claims 2,6,20, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claims 2,6,20, and 22 to include that the authentication method may include a "handheld computing device and digital certificate". Careful review of applicant's Specification revealed no support for this

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authentication method. Appropriate correction or a specific reference to where this limitation is disclosed is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2,5-6,14-16,19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stockwell, U.S. Patent No. 5,950,195.

As per claims 1,5,14-16,19, and 21, the applicant describes a method for facilitating the selection of at least one authentication method for accessing a restricted service comprising the following limitations which are met by Stockwell:

- a) enabling a user to select a method of authentication for access to the restricted service, wherein the restricted service requires a method of authentication in order to gain access to the restricted service (Col 6, lines 16-27);
- b) registering the user-selected method of authentication which facilitates the user's ability for gaining access to the restricted service (Col 6, lines 16-65);
- c) presenting the registered method of authentication as the method of authentication for access to the restricted service (Col 6, lines 16-65);
- d) wherein the user is enabled to select a different method of authentication for access to the restricted service without accessing the restricted service (Col 6, lines 16-65).

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As per claims 2,6,20, and 22, the applicant describes the method of claims 1,5,19, and 21, which are met by Stockwell, with the following limitation which is also met by Stockwell:

Wherein the method of authentication includes at least one of user identification and password; user identification and pass-phrase; smart card and PIN; smart card and digital certificate; biometrics; sound verification; radio frequency and password; infrared and password; and handheld computing device and digital certificate (Col 6, lines 16-27).

As per claim 4, the applicant describes the method of claim 1, which is met by Stockwell, with the following limitation which is also met by Stockwell:

Further comprising the step of registering the user-selected method of authentication as a minimum level of security for authentication for the user (Col 6, lines 16-27).

The selected method of authentication is a minimum level of security for authentication because at least the selected method must be performed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stockwell in view of Microsoft (Microsoft. Enabling and Configuring Authentication. 1999. www.freshinvest.com/iis/htm/core.iiauths.htm).

As per claims 3 and 7, the applicant describes the method of claims 1 and 5, which are met by Stockwell, with the following limitation which is met by Microsoft:

Further comprising the step of enabling the user to select more than one method of authentication for access to the restricted service (Microsoft: page 1);

Stockwell discloses all the limitations of claims 1 and 5. However, Stockwell does not appear to disclose the idea of selecting more than one authentication method. Microsoft discloses that more than one authentication method may be selected. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Microsoft with those of Stockwell and use more than one authentication method for the purpose of increased security.

Response to Arguments

Applicant's arguments, see Remarks, filed 5/19/06, with respect to the 112, first paragraph, rejection of claims 1-7,14-16, and 19-24 as lacking support in the specification have been fully considered and are persuasive. The 112, first paragraph, rejection of claims 1-7,14-16, and 19-24 has been withdrawn.

Applicant's arguments with respect to the 112, first paragraph, rejection of claims 2,6,20, and 22, as lacking support in the specification have been fully considered, but they are not persuasive. More specifically, Examiner rejected the claims on the grounds that the newly amended limitation that the method of authentication may include "handheld computing device" (see Claims filed 12/5/05) lacks support in the specification. Careful review of the specification does reveal that the method of authentication may be "palm pilot". However, a palm pilot is merely one type of handheld computing device, and does not encompass the full extent of any handheld computing device as claimed in Applicant's newly amended claim language.

In his latest Remarks, Applicant argues that "one skilled in the art would recognize that the terms 'palm pilot' denotes a brand of handheld computing device" (Remarks 5/19/06: page 1, last sentence of third paragraph). Examiner does not dispute the foregoing. However, it is axiomatic that Applicant's recognition of one particular type of handheld computing device (i.e. "palm pilot") does not by itself

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provide disclosure for any handheld computing device as claimed. Accordingly, the rejection is maintained.

Applicant's arguments with respect to the 102(e) rejection of claims 1-4,6-7,14-16, and 19-24 under Hillhouse have been fully considered. The rejections have been withdrawn in the instant action. Therefore, Applicant's arguments are moot.

Applicant's arguments with respect to the 102(b) rejection of claims 1-2,5-6,14-16, and 19-24 under Stockwell have been fully considered, but they are not persuasive. More specifically, Applicant argues claim 1 and presents the following argument as to why claim 1 is not anticipated by Stockwell:

1) Stockwell does not teach or suggest "registering the user-selected method of authentication" as claimed in part b

More specifically with regards to 1), Applicant argues that Stockwell merely provides a list of allowed authentication methods from which the user can choose and thus cannot teach "registering the user-selected method of authentication" as claimed in part b. Based on the foregoing, Applicant further argues that Stockwell cannot teach "presenting the registered method of authentication" as claimed in part c.

Examiner respectfully disagrees. Stockwell teaches a method of authentication for access to a restricted service. More specifically, if a user desires access to a restricted service and authentication is needed, a user may be presented with a menu of choices of allowed authentication methods for access to the restricted service (Col 6, lines 18-22) (part a). Typical authentication methods include plain password, SNK DSS, SKI SecurID, etc (Col 6, lines 18-22). Thus, a user may select or register one of the authentication methods from the menu of choices and, in turn, be required to perform the registered method of authentication. For example, a user may select "plain password" from the menu of choices and thus be required to present the "plain password" as the method of authentication for access to the restricted service (parts b and c). Finally, the user is enabled to select a different method of

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authentication for access to the restricted service without accessing the restricted service. For example, the user is enabled to select "SNK DSS" instead of "plain password" (part d).

Conclusion

5 This action is made non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where
10 this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
15 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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